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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,628	07/20/2001	Judith L. Erb	3060.00021	3205

7590 06/19/2003

Kohn & Associates  
Suite 410  
30500 Northwestern Highway  
Farmington Hills, MI 48334

EXAMINER

CHIN, CHRISTOPHER L

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

13

# Office Action Summary

Application No.  
09/910,628

Applicant(s)  
Erb et al

Examiner  
Chris L. Chin

Art Unit  
1641



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 20, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- ### Disposition of Claims
- 4) ☒ Claim(s) 43-49 is/are pending in the application.
- 4a) Of the above, claim(s) 46, 47, and 49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-45 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 43-49 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election with traverse of Group I - claims 43-45 and 48 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that all of the groups relate to an apparatus and methods for using the apparatus and are classified in the same class. Since there is a great amount of cross-classification amongst the sub-classes in this class, examination of all of the claims in a single application would be efficient. This is not found persuasive because the search for the apparatus would not necessarily include a search for the method of use of the apparatus. Also, different search terms are required for the apparatus on commercial data bases.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 U.S.C. § 112***

2. Claims 43-45 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 43 is vague and confusing. The preamble of the claim recites a "pharmaceutical screen" which is not clear if Applicants are intending to claim an apparatus, as previously recited, or a method. The body of the claim does not recite any method steps but the recitation of "screen" suggests a screening method. The claim is also vague with respect to how the molecular tag

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functions. The claim states that the molecular tag is affected by binding of the receptor molecules to the first type of molecules on the surface of the sensing device. However, the last part of the claim states that the molecular tag is not attached to the first type of molecules but to a second type of molecules which also has affinity for the receptor molecules. Binding of the receptor molecules to the first type of molecules can't affect the molecular tag since the molecular tag is not attached to the first type of molecules.

### *Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patents 4,447,546; 4,558,014; 4,608,344; and 4,671,938 disclose evanescent sensors for performing immunoassays.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Chin whose telephone number is (703) 308-3991. The examiner can normally be reached on Monday-Thursday from 10:00 am to 7:30 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

cchin/cc  
June 16, 2003



CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800-1641